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In re Application of :
GRANT et al. :
Application No.: 10/538,164 :
PCT No.: PCT/US03/38961 :
Int. Filing Date: 08 December 2003 :
Priority Date: 08 December 2002 :
Attorney Docket No.: IMMR-0152E(034701-518) :
For: HAPTIC COMMUNICATION DEVICES :

DECISION ON REQUEST

This decision is issued in reply to applicants' response to Notification of Missing Requirements filed 02 June 2006, which is being treated as a request under 37 CFR 1.497(d) to correct the inventorship of the present national stage application. Deposit Account No. 50-1698 will be charged the required petition fee.

BACKGROUND

On 08 December 2003, applicants filed international application PCT/US03/38961 which claimed a priority date of 08 December 2002. The published international application identified three applicant/inventors for the United States: Danny Grant; Jeffrey Eid; and Schoichi Endo. The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 08 June 2005.

On 08 June 2005, applicants filed a transmittal letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee; a preliminary amendment; and a copy of the international application.

On 30 March 2006, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a two-month time limit in which to respond.

On 02 June 2006, applicants filed the present request under 37 CFR 1.497(d) to add inventors Dean C. Chang and Erik J. Shahoian.

DISCUSSION

The present submission seeks to correct the inventorship so as to add inventors Dean C. Chang and Erik J. Shahoian¹ to the application. Where, as here, the inventorship in the national stage declaration is not consistent with the inventorship in the international application, applicants must correct the inventorship pursuant to 37 CFR 1.497(d), which states the following:

(d) If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by:

(1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;

(2) The processing fee set forth in § 1.17; and

(3) If an assignment has been executed by any of the original named inventors, the written consent of the assignees (see § 3.73(b) of this chapter).

(4) any new oath or declaration required by paragraph (f) of this subsection.

Item (1) has not been satisfied. The statement provided by Erik J. Shahoian is not acceptable pursuant to 37 CFR 1.497(d)(1). Specifically, the statement includes no alteration to Mr. Shahoian's name that has not been explained or initialed. Therefore, a newly executed statement which explains the alteration and asserts that the error in inventorship occurred without deceptive intent is required.

The statement from Dean C. Chang is acceptable pursuant to 37 CFR 1.497(d)(1).

Item (2) has been satisfied. The \$130 petition fee will be charged to Deposit Account no. 50-1698.

Item (3) has not been satisfied. Applicants have submitted a statement of consent from the purported assignee which consents to the addition of inventor Erik J. Shohian, not Erik J. Shahoian.

Item (4) has not been satisfied. The declaration filed on 02 June 2006 is not in an acceptable form. Specifically, there is an issue as to whether the declaration has been

¹It appears that the correct name of the added inventor is Erik J. Shahoian.

properly executed. The declaration filed with petition includes duplicate sheets of page 4. It is unclear if the inventors were presented with only page 4, in which case the execution would be improper, or if they were presented with a complete declaration for signing, but counsel subsequently compiled the declaration into the single document, which is improper. (See MPEP 201.03(B) on how to correct this matter)

Additionally, the declaration submitted includes an alteration to the fourth inventor's name. (See MPEP §605.04(a) and 37 CFR 1.52(c)) Any changes made in ink in the application or oath prior to signing should be initiated and dated by the applicants prior to execution of the oath or declaration. The Office will not consider whether non-initialed and/or non-dated alteration were made before or after signing of the oath or declaration but will require a new oath or declaration. See MPEP 605.04(a). Therefore, a newly executed declaration is required.

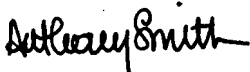
Because applicants have not satisfied all the requirements of 37 CFR 1.497(d), inventors Dean C. Chang and Erik J. Shahoian cannot be added to the application on the present record.

CONCLUSION

Applicants' request to add inventors Dean C. Chang and Erik J. Shahoian under 37 CFR 1.497(d) is **DISMISSED** without prejudice. The inventors of record remain the inventors named on the international application.

Applicants must file a proper response to this decision within **TWO (2) MONTHS** from the mail date indicated above. Failure to file a timely and proper response will result in abandonment of the application. Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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